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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,848	02/20/2004	Jef De Brabander	049763-0111	7487
22428 7590 05/18/2010 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			EXAMINER O DELL, DAVID K	
			ART UNIT 1625	PAPER NUMBER
			MAIL DATE 05/18/2010	DELIVERY MODE PAPER

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JEF DE BRABANDER and XIBIN LIAO

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Appeal 2009-013741  
Application 10/783,848  
Technology Center 1600

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Decided: May 18, 2010

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Before TONI R. SCHEINER, DONALD E. ADAMS, and  
STEPHEN WALSH, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

Claims 3, 6-12, 14, 17, 23-28 are pending in this application (Ans. 3<sup>1</sup>; App. Br. 5).<sup>2</sup> Of the remaining pending claims, claim 3 has been held to be allowable and claims 14, 17, and 24-28 were withdrawn from consideration in response to a restriction requirement (App. Br. 5). Claims 6-12 and 23 stand rejected under the first and second paragraphs of 35 U.S.C. § 112. Appellants, however, withdrew claim 6 from this Appeal (App. Br. 5 (“Appealed claims: 7-12 and 23”)), and confirmed the non-appeal of claim 6 in a corrected “Status of Claims” filed Feb. 4, 2009 (Appellants’ Response To Notification Of Non-Compliant Appeal Brief).

We interpret Appellants’ withdrawal of claim 6 from this Appeal as authorization to cancel claim 6. Manual of Patent Examining Procedure §§ 1214.05 and 1215.03 (Rev. 3, August 2005). Upon receipt of this opinion and prior to taking further action on the merits the Examiner should notify the Appellants of the cancellation of withdrawn claim 6.

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<sup>1</sup> The Answer is not paginated consecutively. For example, while the first 9 pages of the Answer are consecutively numbered, the two pages following page 9 are both numbered “Page 2,” with the numbering scheme continuing consecutively thereafter. For clarity, we refer to page numbers as if the Answer was numbered consecutively, starting with the first page.

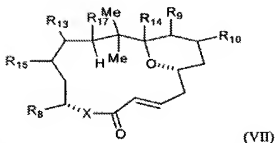
<sup>2</sup> The status of claim 25 is unclear. Appellants identify claim 25 as pending, but withdrawn from consideration (App. Br. 5). The Examiner does not identify the status of claim 25 (*see* Ans. 3). Appellants’ Amendment received February 12, 2008 identifies the status of claim 25 as canceled (February 12, 2008 Amendment 20). However, this same Amendment states that “Applicants previously cancelled claims 1, 2, 4, 5, 13, 15, 16, and 18-22. In response to Appellants’ election, the PTO withdrew claims 14, 17, 24-28 from consideration. No claims are presently cancelled” (*id.* at 22). Given this ambiguity we have included claim 25 in our listing of the status of the claims. In the event of further prosecution, Appellants and the Examiner should work together to resolve the status of claim 25 on this record.

Accordingly, this appeal under 35 U.S.C. § 134 involves claims 7-12 and 23. We have jurisdiction under 35 U.S.C. § 6(b).

### STATEMENT OF THE CASE

The claims are directed to a compound. Claim 7 is representative:

7. A compound of formula:



where R<sub>13</sub> is H or Me, where R<sub>14</sub>, R<sub>17</sub> can be the same or different and is selected from the group consisting of H, OH, or OR, where R<sub>9</sub>, R<sub>10</sub>, R<sub>15</sub> can be the same or different and are selected from the group consisting of H, Me, OR, where R is selected from the group consisting of H, Me, alkyl, or functionalized alkyl, where R<sub>8</sub> is selected from the group consisting of H, aryl, heteroaryl, alkyl, functionalized alkyl, alkenyl, functionalized alkenyl, alkynyl, and functionalized alkynyl, where X is O or NH, and wherein each functionalized group is substituted with a halide, an aryl, or a heteroaryl.

The evidence relied upon by the Examiner is recited in the Answer (Ans. 4-5). The evidence relied upon by Appellants is recited in the Evidence Appendix of the Appeal Brief (App. Br. 29).

The rejections presented by the Examiner follow:

1. Claims 7<sup>3</sup>-12 and 23 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite.
2. Claims 7<sup>4</sup>-12 and 23 stand rejected under the enablement provision of 35 U.S.C. § 112, first paragraph.

We affirm.

## ISSUE

Are the terms “functionalized alkyl,” “functionalized alkenyl” and “functionalized alkynyl” indefinite in the context of Appellants’ claimed invention?

## ANALYSIS

The claims have not been argued separately and therefore stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Claim 7 is representative.

The Examiner finds that it is unclear what groups/structures the terms “functionalized alkyl,” “functionalized alkenyl” and “functionalized alkynyl” represent (Ans. 5).

For their part, Appellants contend that “the claims specify what substituents are present to qualify a group as being functionalized” (App. Br. 20). Apparently, Appellants contention is based on the recitation in claim 7

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<sup>3</sup> The Examiner included claim 6 in the statement of the rejection. However, as discussed above, Appellants withdrew claim 6 from this appeal and thereby authorized the cancellation of this claim. Accordingly, we have not considered the merits of claim 6 on this Appeal.

<sup>4</sup> Ibidem.

that states “wherein each functionalized group is substituted with a halide, an aryl, or a heteroaryl” (Claim 7).

The Examiner does not, however, interpret this limitation as a definition of the functionalized group, but instead interprets this limitation as a requirement that the “functionalized” groups themselves are substituted with a halide, an aryl, or a heteroaryl groups (Ans. 6).

In response, Appellants contend that the requirement in claim 7 “that ‘each functionalized group is substituted with a halide, an aryl, or a heteroaryl’” does not represent a further substitution of the functionalized group itself; but instead defines the functionalized group. “In other words, a given moiety, such as a functionalized alkyl, is functionalized *by virtue of it being* substituted with a halide, an aryl, or a heteroaryl” (Reply Br. 2).

From the foregoing, it is clear that the claims are amenable to, at least, the following two plausible claim constructions, based on the phrase “wherein each functionalized group is substituted with a halide, an aryl, or a heteroaryl,” as it appears in claim 7:

(a) that the phrase *does not* define the functionalized group itself, e.g., the group that functionalizes the alkyl, but instead requires the undefined functionalized group to be substituted with a halide, an aryl, or a heteroaryl; or

(b) that the phrase *does* define the functional group, e.g., the group that functionalizes the alkyl, as a halide, an aryl, or a heteroaryl.

It is “during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). “[I]f a claim is amenable to two or more plausible claim constructions, the

USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008). Accordingly, we affirm the rejection under the second paragraph of 35 U.S.C. § 112.

We also agree with the Examiner’s finding that the ambiguity with regard to the term “functionalized” as it is used in Appellants’ claims “has an impact on the enablement rejection, because it is not possible to evaluate the full scope” of Appellants’ claimed invention (Ans. 14; *see also* Ans. 16). “[S]peculation as to meaning of the terms employed and assumptions as to the scope of such claims” is legal error. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). Further

What is of maximum concern in any analysis of whether a particular claim is supported by the disclosure in an application is whether that disclosure contains sufficient teaching regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and to use the claimed invention.

*In re Moore*, 439 F.2d 1232, 1236 (CCPA 1971). Appellants’ response fails to identify a portion of their Specification that clarifies the foregoing ambiguity or establishes that their disclosure provides an enabling description of the claimed subject matter, as it relates to functionalized groups. Similarly, the De Brabander Declarations<sup>5</sup> also fail to address a compound comprising a “functionalized alkyl,” “functionalized alkenyl” and/or “functionalized alkynyl.” Accordingly, we affirm the rejection under the enablement provision of 35 U.S.C. § 112.

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<sup>5</sup> *See* De Brabander Declaration, executed October 27, 2006 and De Brabander Declaration, executed February 12, 2008.

Arguments not made are waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

#### CONCLUSION OF LAW

The terms “functionalized alkyl,” “functionalized alkenyl” and “functionalized alkynyl” are indefinite in the context of Appellants’ claimed invention.

The rejections of claims 7-12 and 23 under 35 U.S.C. § 112, second paragraph, as indefinite and under the enablement provision of 35 U.S.C. § 112, first paragraph are affirmed.

#### TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

#### AFFIRMED

cdc

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